

### **REMARKS/ARGUMENTS**

Applicant has carefully reviewed the Office Action mailed on October 1, 2008. Applicant respectfully traverses all objections, rejections, and assertions made by the Examiner. Claims 1-4, 6-11, 14-16, 18-22, 28, and 29 remain pending.

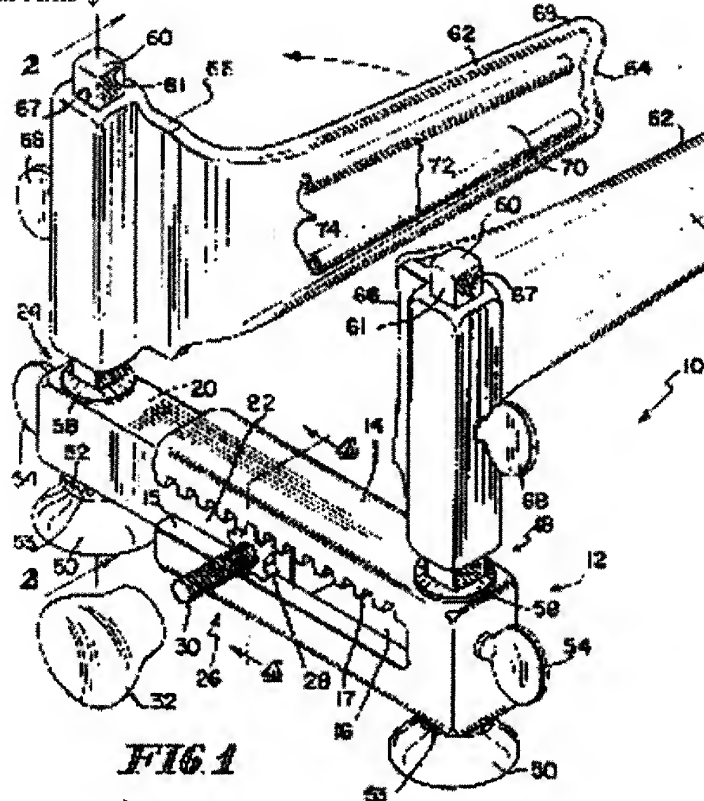
#### **Claim Rejection under 35 U.S.C. §102**

Claims 1, 3-4, 6, 9, 11, 18-19, 21-22 and 28-29 were rejected under 35 U.S.C. §102(b) as being anticipated by Burgin (U.S. Patent No. 4,156,424). This rejection is respectfully traversed. The Examiner asserts the device of Burgin would be capable of distracting vertebrae in an axial direction if one chooses to do so, and this is considered a functional limitation. Applicant respectfully disagrees. Burgin does not appear to teach the identical invention. MPEP 2131 states:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Emphasis added. Burgin does not appear to teach the identical invention in as complete detail as is contained in the claims and thus cannot be deemed to anticipate the claims. The Examiner appears to be considering the use of “horizontal orientation” and “vertical orientation” in the claims as merely arbitrary terms related to the intended use of the device. Applicant respectfully disagrees and submits that the actual claim language relates the orientation of the paddles to the base, thus the terms “horizontal” and “vertical” refer to the structure of the device and not intended use. Burgin does not appear to teach the identical structure recited in the claims. Burgin appears to teach a speculum with a base 12 and members 62 detachably engaging a portion of an elongated rotatable shaft 56 extending vertically from the base 12 such that the members 62 pivot about a vertical axis with respect to the base 12. The vertical axis shown in FIG. 1 is indicated in the marked-up copy of FIG. 1 below. See also FIGS. 2 and 3 showing the members 62 pivoting about the vertical axis, and column 3, lines 26-65.

Vertical Axis ↓



As can be seen in the above FIG. 1, Burgin appears to teach a device in which the members 62 are vertically oriented with respect to the base 12 in both the open and closed positions.

If the Examiner is considering viewing the device of Burgin such that the indicated vertical axis is a horizontal axis, Burgin still does not appear to teach the identical structure as recited in the claims. The Examiner asserts that the paddles 62 of Burgin appear to have a curved profile to address the Lordotic curvature, thus the Examiner appears to be considering the upper and lower surfaces of members 62 in the orientation shown in the above FIG. 1 as providing distraction between adjacent vertebrae. However, if the Examiner were considering rotating the device such that the indicated vertical axis as a horizontal axis, the device would be inserted with the edge 64 and the edge near reference number 67 somehow providing distraction between adjacent vertebrae. Applicant submits that such an orientation does not provide the structure recited in the claims.

The Examiner also asserts that at least portion 66 of the paddles of Burgin can be considered horizontal, depending on how one looks at the device and from what point it is considered open and closed. Applicant submits that even if one considered portion 66 of Burgin, the device does not have the claimed structure. As seen in the above FIG. 1, Burgin teaches portion 66 rotating about the vertical axis of the shaft 60.

Independent claim 21 recites, "an actuator for insertion of the flip-up portal into a disc region between two vertebrae, the actuator including at least one handle that is rotated to move the first and second paddles from the closed position to the open position". The Examiner has not addressed this element. Burgin does not appear to teach or suggest such an element, thus Burgin cannot be seen to anticipate the claim. Burgin does not appear to teach a device with the identical structure recited in the claims and thus cannot be deemed to anticipate the claims. Reconsideration and withdrawal are respectfully requested.

#### **Claim Rejections under 35 U.S.C. §103**

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Burgin (U.S. Patent No. 4,156,424) in view of Brantigan (U.S. Patent No. 5,425,772). Claims 14 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Burgin (U.S. Patent No. 4,156,424) in view of Baynham et al. (U.S. Patent No. 6,224,599). Claims 2, 16, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Burgin (U.S. Patent No. 4,156,424). Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Burgin (U.S. Patent No. 4,156,424). These rejections are respectfully traversed.

For at least the reasons set forth above, Burgin does not appear to disclose each element of independent claims 1, 11, and 18. Neither Brantigan nor Baynham et al. appear to teach or suggest what Burgin lacks, thus even if one were to make the asserted combinations, one would not arrive at the invention as recited in the dependent claims. Claims 2, 7, 8, 10, 14, 15, 16, and 20 are thus distinguished from the prior art. Applicant respectfully requests withdrawal of the rejections.

**CONCLUSION**

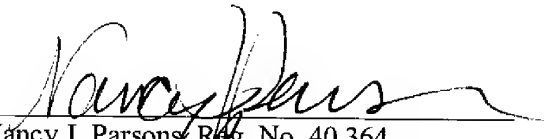
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Jack A. DANT

By his attorney,

Date: 12/30/08

  
Nancy J. Parsons, Reg. No. 40,364  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349